

REMARKS

Summary of the Office Action & Formalities

Claims 17-20 are all the claims pending in this divisional application. By this Amendment, Applicant is amending the abstract of the disclosure and claim 17, and adding new claims 21-29. No new matter is added.

Applicant thanks the Examiner for initialing the references listed on form PTO/SB/08 submitted with the Information Disclosure Statement filed on February 14, 2002.

The abstract of the disclosure is objected to for minor informalities. Applicant is amending the abstract of the disclosure to overcome this objection.

The prior art rejections are summarized as follows:

1. Claims 17, 19, and 20 are rejected under 35 U.S.C. § 102(b) as being anticipated by Popat (USP 5,997,683).¹

2. Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Popat (USP 5,997,683) in view of Shingu et al. (USP 5,824,178).

Applicant respectfully traverses.

Claim Rejections – 35 U.S.C. § 102

In rejecting claim 17, the Examiner states:

As outlined in the abstract, Popat teaches a method of printing an image on a printing paper using a laser printer. Popat teaches in column 5 lines 1-4, the step of accommodating a printing paper in an accommodating portion 58. Popat also teaches

¹ Applicant believes that Examiner mistakenly relied on 35 U.S.C. § 102(b), instead of 35 U.S.C. § 102(e), to reject Applicant's claims. Popat is not prior art under 35 U.S.C. § 102(b).

the step of conveying the printing paper from the accommodating portion to a recording device in column 5 lines 10-11. Figure 3 also illustrates the feeding with arrows 70. Column 5 lines 18-21 teach the step of printing an image on the printing paper by the recording device.

With respect to the step of conveying the printing paper from the recording device to a discharging portion, Figure 2 shows a discharging portion on top of the printer, where the printing paper is discharged after printing. **Although Popat does not specifically state that the conveying device nips margins of the printer, the applicant should note this is an inherent step in conventional printers as illustrated in Figure 2. In the feeding process, the printer of Popat must nip at least portions of ‘margins’ of the printer, to the extent that dimensions of margins are defined by the applicant.**

Popat also teaches the step of providing printing paper with printing portions and margins, illustrated in Figures 5, 6, 7, and 9. As outlined in column 4 lines 21-26, detaching at least one printing portion from the printing paper after the printing paper with an image is discharged to the discharging portion forms the print.

Office Action at pages 2-3 (emphasis added).

Anticipation, under 35 U.S.C. § 102, requires the reference to “teach every aspect of the claimed invention either *explicitly* or *impliedly*. Any feature not directly taught must be *inherently* present.” Manual of Patent Examining Procedure (“MPEP”) § 706.02; *see also* MPEP § 2131. Applicant respectfully submits that this standard has not been met in the present case with respect to amended claim 17.

As amended, claim 17 clarifies that

the step of conveying the printing paper from the accommodating portion to the recording device is performed by nipping the printing paper at substantially spaced apart locations *so as to avoid nipping the at least one printing portion of the printing paper.*

As explained in Applicant’s specification, “[i]f at the time of conveying the printing paper, a portion of a printing paper with an image thereon is nipped, defects may be formed on the image.

Therefore, it is preferable to provide margins for nipping.” Specification at page 1, third paragraph. Clearly, in the context of printing images, such as photographs, such defects are extremely undesirable.

Accordingly, Applicant’s invention resolves this problem by ensuring that the nipping is performed outside the image area (*i.e.*, the printing portion) so that when the printing portion is detached after printing, the resulting structure will have no scaring as a result of the nipping activity.

In the grounds of rejection, the Examiner acknowledges that Popat does *not* “specifically state that the conveying device nips margins of the printer. However, the Examiner takes the position that this is an “*inherent*” step in conventional printers as illustrated in Fig. 2 of Popat.

Applicant submits, however, that even if the printer illustrated in Fig. 2 of Popat in fact nips the paper to convey it therethrough, such printers would have nipped the paper across the *entire width* of the paper or would have used multiple nipping rollers cascaded serially *across the width of the paper*. That is, known printers at the time of the present invention would have had nipping rollers that scared the image receiving portion of the printing paper. Accordingly, Popat does not teach or suggest the feature of “conveying the printing paper . . . by nipping the printing paper at *substantially spaced apart locations so as to avoid nipping the at least one printing portion of the printing paper*.” Rather, at most, Popat is silent with respect to this feature. Moreover, the printers known at the time of the invention clearly nipped the paper across its width, such that any images printed out with these printers would have been scared.

In view of at least the foregoing differences, independent claim 17, and dependent claims 18-20 are believed to be allowable, and the Examiner is kindly requested to reconsider and withdraw the rejection of these claims.

Claim Rejections – 35 U.S.C. § 103

Without substantively commenting on the merits of the Examiner's rejection of claim 18, Applicant submits that claim 18 is allowable at least by reason of its dependency on claim 17.

New Claims

For additional claim coverage merited by the scope of the present invention, Applicant has added new dependent claims 21-29, which are believed to be allowable at least by reason of their respective dependencies.

Furthermore, claims 23 and 24 recite additional features relating to the weakened portions for separating the margins of the printing paper from the printing portion. Clearly, the applied art does not disclose or even recognize the need for balancing the objects of: 1) ensuring proper conveyance of the printing paper through the printer, and that of maintaining the high quality appearance of the finished printed product. The additional features recited in claims 23 and 24 require a particular kind of weakened structure involving a plurality of cuts and separating portions to temporarily maintain the integrity of the printing portion with the remainder of the printing paper. In the case of claim 24, it does so while also ensuring the proper adherence of the printing portion to the base material using an adhesive layer. For example, the intermittent cut line assures that the printing paper is not accidentally removed or detached from the printing material during printing. See Specification at page 11. On the other hand, it is important to locate the intermittent cut line only where necessary to ensure the integrity of the

printing paper, thereby minimizing any deterioration in the quality of the final product when the printing portion is detached from the printing material.

With respect to claim 26, the applied art, and in particular Popat, does not teach or suggest the claimed invention for at least two reasons.

First, Popat discloses a label assembly that may be printed upon, where the label assembly thickness varies from 5 to 15 mils. *See* Popat at column 7, lines 65-66 and column 8, lines 3-4. Popat also suggests using a greater or lesser thickness for the label assembly based on the particular application. *See* Popat at column 8, lines 4-7. For example, Popat indicates that the sheet thickness may vary depending on the type of printer and ultimate function of the sheet (labels versus business cards, for example). *See* Popat at column 3, lines 8-12 and column 6, line 8 – column 7, line 15.

In contrast, Applicant's claim 26 requires a substantially equal constant overall thickness for both first and second printing papers, *with at least two layers of the first printing paper each having a substantially different thickness from the corresponding layers of the second printing paper*, regardless of the printing application. Providing a substantially equal overall thickness ensures that the nipping pressure on the printing papers remains constant. As a result, the printing papers are smoothly and reliably conveyed. *See* Applicant's Specification at page 13.

Popat is silent on holding label assemblies at a constant overall thickness for all purposes and, in fact, *teaches away* from this practice. That is, Popat suggests *varying* the label assembly thickness depending upon the particular application.

Second, Popat suggests ranges for the thickness of individual layers within a single label assembly. *See* Popat at column 7, line 62 – column 8, line 8. In contrast, Applicant's claim 17

U.S. APPLICATION NO. 10/073,984
AMENDMENT UNDER 37 C.F.R. § 1.111

requires *at least two* printing papers be provided, each having at least two layers (*i.e.*, two selected from the base material layer, adhesive layer, or printing material layer), each with a different thickness relative to another printing paper's corresponding layer. Popat does not suggest this *relative difference* in layer thickness between at least two label assemblies, but merely suggests a range of thickness values for a single label assembly.

This relative difference in *layer* thickness also provides the distinct advantage that one printing paper may provide prints that are thin, non-bulky and easy to carry, while the other printing paper may provide prints that are thick, strong, and less likely to be damaged. *See Applicant's Specification at page 14.*

With regard to claim 27, the applied art does not disclose printing an image which traverses a weakened portion of a printing paper; nor is this an inherent step in printing an image upon a printing paper. In fact, in embodiments suggested by Popat, such as printing labels and business cards, printing an image that traverses a weakened portion would result in a substantially non-functional finished product. Therefore, Popat *teaches away* from printing an image that traverses the weakened portion of a printing paper.

Allowing for a printed image to traverse the weakened portion of a printing paper provides the advantage of printing the image onto the printing paper in a more stable manner. For example, even if the printing paper is displaced when being conveyed, a desirable print may still be produced with the image extending completely to the edge of the print. *See Applicant's Specification at page 6.*

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

U.S. APPLICATION NO. 10/073,984
AMENDMENT UNDER 37 C.F.R. § 1.111

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Raja Saliba
Registration No. 43,078

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: September 29, 2003